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In re Application of :
SEMSCH, Angelika *et al* :
U.S. Application No.: 08/930,735 :
PCT No.: PCT/DE97/00187 :
Int. Filing Date: 26 January 1997 :
Priority Date: 27 January 1996 :
Attorney Docket No.: 0190 US/P :
For: DEVICE FOR PREVENTING OR :
REDUCING TIPPING OF THE HEAD :

DECISION

This decision is in response to applicants' "Request to Rescind Notification of Abandonment and Reinstatement of Application" filed on 01 December 1998 and "Request for Decision on Applicants' Request for Rescinding the Notice of Abandonment" filed on 07 June 2002 which are treated as a petition under 37 CFR 1.10(c) and a request to withdraw holding of abandonment. No fee is required.

BACKGROUND

On 23 November 1998, a communication was mailed notifying applicants that the above-captioned application was abandoned for failure to enter the national stage by the expiration of 20 months from the earliest claimed priority date. The national stage papers were deemed received on 30 September 1997. The communication also noted that even if the above-identified application were considered to be timely filed, the papers did not include a small entity statement or authorization to charge additional fees. Therefore, the application would be held abandoned because the basic national fee for a small entity was paid.

On 01 December 1998, applicants filed a "Request to Rescind Notification of Abandonment and Reinstatement of Application" along with a copy of Express Mail label No. EM405382687US and the date stamped postcard receipt for the national stage papers via facsimile.

On 11 December 2000, applicants filed a "Status Letter."

On 07 June 2002, applicants filed via facsimile a "Request for Decision on Applicants' Request for Rescinding the Notice of Abandonment" which was accompanied by, *inter alia*, a copy of the "Request to Rescind Notification of Abandonment and Reinstatement of Application" filed on 01 December 1998.

DISCUSSION**Petition Under 37 CFR 1.10(c)**

Any correspondence received by the Patent and Trademark Office delivered by "Express Mail" will be considered filed in the office on the date of deposit with the USPS. 37 CFR 1.10(a). Moreover, 37 CFR 1.10(c) states that:

Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date - in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date - in" on the "Express Mail" mailing label or other official USPS notation, provided that:

- (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
- (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and
- (3) The petition includes a true copy of the "Express Mail" mailing label showing the "date - in," and of any other official notation by the USPS relied upon to show the date of deposit.

In the petition filed 01 December 1998, applicants submitted a copy of Express Mail label No. EM405382687US which has a "Date In" listed as "9 29 97" and a date stamp of "SEP 29 1997" located on its face. Moreover, a review of the above-captioned application reveals that the Express Mail label No. EM405382687US was listed on a document titled "Verified Certification of Express Mailing Date" filed with the national stage papers. This document verified that the national stage papers were filed with the USPS on "09/29/97." This petition is timely filed.

Applicants have met all the requirements of 37 CFR 1.10(c).

The date of receipt of the national stage papers is **29 September 1997.**

Request to Withdraw Holding of Abandonment

As previously stated in the communication mailed 23 November 1998, the national stage papers filed 29 September 1997 did not include a small entity statement or authorization to charge additional fees to counsel's Deposit Account. Therefore, the application would be held abandoned even if it was timely filed.

In the request dated 01 December 1998, applicants argue that: (1) they relied on a statement contained in the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 10 December 1997 that the large entity fee would be charged to counsel's deposit account, and (2) counsel filed the required small entity statement within one month from receipt of the Form PCT/DO/EO/905 on 16 January 1998. Applicants therefore claim that the "application should be returned to regular pending status and the Notification of Abandonment should be rescinded."

These arguments have been considered and dismissed.

A review of the above-captioned application reveals that applicants submitted a check of \$520.00 with the national stage papers. The proper basic national fee for the above-captioned application was \$910.00. The box next to the authorization to charge any additional fees to counsel's Deposit Account on the Form PTO-1390 was not checked even though the Deposit Account No. was listed.

Accordingly, the USPTO had no authority to charge the full basic national fee on 29 September 1997 to prevent the above-captioned national stage application from being abandoned. Therefore, the application became abandoned on 30 September 1997 for failure to pay the required basic national fee pursuant to 37 CFR 1.494(b)(2).

Since the above-identified application was already abandoned prior to the mailing of the Form PCT/DO/EO/905 on 10 December 1997, applicants could not have detrimentally relied on a statement that the large entity fee would be charged to counsel's deposit account. Moreover, the subsequent filing of a small entity statement does not affect the abandoned status of the application.

CONCLUSION

Applicants' petition pursuant to 37 CFR 1.10(c) is **GRANTED**. However, the request to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The above-captioned remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any

reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw Holding of Abandonment."

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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